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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,584	11/28/2000	Kenneth W. Wood	UCSD-04870	9473

23535 7590 07/01/2003  
MEDLEN & CARROLL, LLP  
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SAN FRANCISCO, CA 94105

EXAMINER

HOLLERAN, ANNE L

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 07/01/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/724,584

Applicant(s)

WOOD ET AL.

Examiner

Anne Holleran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 15-38 and 40-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 16-38 and 40-42 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43 is/are allowed.
- 6) ☒ Claim(s) 12, 15 and 44-46 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. The amendment filed March 12, 2003 (Paper No. 12) is acknowledged. Claims 14 and 39 were canceled. Claims 12, 13, 15 were amended. Claims 43-46 were added.

Claims 1-13, 15-38 and 40-46 are pending.

Claims 1-11, 16-38 and 40-42, drawn to non-elected inventions, are withdrawn from consideration.

Claims 12, 13, 15 and 40-46 are examined on the merits.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections/Objections Withdrawn:***

3. The objection to the specification because the application is not in compliance with the sequence rules set forth in 37 CFR 1.821(a)(1) and (a)(2) is withdrawn in view of the submission of a request under 37 CFR 1.821(e). The application is now in compliance with the sequence rules.

4. The rejection of claims 12-15 and 39 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendment to claim 12 and the cancellation of claim 39.

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5. The rejection of claims 12, 14, 15 and 39 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is withdrawn in view of the amendments to claims 12 and 15 and cancellation of claims 14 and 39.

6. The rejection of claims 12, 14, and 15 under 35 U.S.C. 102(b) as being rejected by Yen (Yen, T.J., et al, Nature, 359: 536-539, 1992; cited in the IDS) is withdrawn in view of the amendments to claims 12 and 15 and the cancellation of claim 14.

7. The rejection of claim 39 under 35 U.S.C. 103(a) as being unpatentable over Brown (Brown, K.D, et al, J. Cell Biology, 125: 13003-1312, 1994) in view of Hyman (Hyman and Mitchison, Nature, 351: 206-211, 1991; cited in the IDS) is withdrawn in view of the cancellation of claim 39.

***Claim Rejections Maintained:***

8. The rejection of claims 12 and 15 under 35 U.S.C. 112, first paragraph, because the specification fails to enable the full scope of the claims is maintained for the reasons of record. This rejection is applied to new claims 44-46.

The amendment to claim 12, from which claims 15 and 44-46 depend, is not sufficient to overcome the rejection of record, because the claims fail to recite the activity of the encode protein. In view of the fact that percent identity language renders the scope of the claims large,

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and further in view of the unpredictability of protein function with respect to changes in primary amino acid sequence, the specification fails to support the full scope of the claims.

### *Conclusion*

Claim 13 is objected to for depending from a rejected claim. Claim 43 is allowed.

Claims 12, 15, and 44-46 are rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Office should be directed to Anne Holleran, Ph.D. whose telephone number is (703) 308-8892. Examiner Holleran can normally be reached Monday through Friday, 9:30 am to 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached at (703) 308-3995.


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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0196.

Anne L. Holleran  
Patent Examiner  
June 29, 2003

  
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